



Paper No. 8

IP Department  
Schnader Harrison Segal & Lewis  
36th Floor  
1600 Market Street  
Philadelphia, PA 19103

In re Application of :  
Nakamaru et al. :  
Application No. 10 045,848 : **DECISION ON PETITION**  
Filed: November 7, 2001 :  
Attorney Docket No. 1315-01 :

This is a decision on the renewed petition filed August 29, 2002, requesting, in effect, that pages 2, 3, 13, 17, and 19 filed on April 11, 2002, be entered as part of the original disclosure.

The petition is **dismissed**.

The application was filed on November 7, 2001. On March 4, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s)" stating that the application had been accorded a filing date of November 7, 2001, and advising applicants that pages 2, 3, 13, 17, and 19 appeared to have been omitted.

Petitioner alleges that pages 2, 3, 13, 17, and 19 were filed with the original application.

All the evidence present in the file has been carefully considered, but is not persuasive that pages 2, 3, 13, 17, and 19 were submitted with the original application.

The postcard receipt:

Petitioner argues that the postcard receipt was properly itemized. A postcard receipt is prima facie evidence because, upon receipt of the application, a disinterested individual compares the postcard receipt to the contents of the application. The individual ensures each item listed on the postcard is present and then the postcard is returned to applicant. If the postcard lists "Specification," the individual will review the application to see if a specification is present. The individual will not count the number of pages of specification or read the specification to see if pages may be missing. If the postcard lists "10 pages of specification," then the individual will review the application to see if 10 pages of specification are present. Petitioner's postcard only proves that the individual who reviewed the application and postcard verified that a specification was present. The Office does not dispute that a specification was filed on November 7, 2001, and if such a dispute arose, the postcard receipt would serve as prima facie evidence that something purporting to be a specification was filed on November 7, 2001. The Office disputes the number of pages of specification filed. Since the individual who mailed the postcard back to applicant did not count the number of pages of specification, the receipt of the return postcard cannot serve as evidence that pages 2, 3, 13, 17, and 19 were present.

The declarations submitted:

The order of review of the application papers is unclear. Apparently, Regina Belitz reviewed the papers and then gave them to Daniel Christenbury. Subsequently, Christenbury and Ginola Johnson reviewed the papers, whereupon one of these individuals placed the application in the envelope

Petitioner raises the issue as to the extent to which declarations should be accepted to establish a filing date for an application or portions of an application. The Commissioner has refused to accept mere declarations in order to prove the filing date of an application. The contents of an application are just as critical as the filing date for an application. Regarding the filing date issue, the Office expressly rejected reliance solely on evidence from an applicant when the Office rejected the use of 37 CFR 1.8 for purposes of obtaining a filing date.<sup>6</sup> 37 CFR 1.8 provides a procedure by which the timely filing of papers and fees deposited with the U.S. Postal Service may be established *without independent corroboration by an employee of the U.S. Postal Service*. The criticality of an application filing date was considered adequate to justify independent verification by an employee of the U.S. Postal Service of the date of deposit of the application papers with the U.S. Postal Service. Put simply, the insertion by a disinterested employee of the U.S. Postal Service of the date of deposit in the U.S. Postal Service by Express Mail on the Express Mail label of the envelope containing application papers is the *raison d'être* of 37 CFR 1.10.<sup>7</sup> Postal employees are presumed to discharge their duties in a proper manner.

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<sup>6</sup> *Federal Register* at 48 Fed. Reg. 2696 (January 20, 1983), and in the Patent and Trademark Office *Official Gazette* at 1027 O.G. 9 (February 1, 1983) ("Comment: One person commented that he found the idea of using a declaration or affidavit to establish a date of deposit unacceptable because it exposes the integrity of the assignment of filing dates to the risk of deception. Reply: The use of declarations or affidavits is usually intended to help explain activities which can be supported by exhibits. For example, if the Office copy of the mailing label was not entirely readable, applicant's copy of the "Express Mail" mailing label could accompany a declaration and serve as the basis for granting a filing date.")

*Hongshaumy, Lehman*, 903 F. Supp. 8, 37 F. SPQ2d 1799 (D.D.C. 1995) ("Plaintiff thereafter submitted three affidavits, a declaration, and copies of two pages of records from his attorney's law firm, but the Commissioner finally denied plaintiff's petition for a filing date on the grounds that, if plaintiff had used Express Mail properly, he would have had an Express Mail receipt showing the actual date of mailing, and that the materials later submitted by the plaintiff were not good enough proof

The materials plaintiff gathered together included a photocopy copy of an Express Mail label that is undated and bears no evidence of any U.S. Postal Service handling. Nothing submitted by plaintiff to the Patent and Trademark Office is corroborated by anything outside the office of the submitting counsel. It was the view of the Commissioner of Patent and Trademarks that these circumstances did not establish the extraordinary conditions that might warrant a waiver.

The decision was for the Commissioner to make, and I cannot find on the basis of the record presented to me that the Commissioner's decision was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law." *Id.*, aff'd without opinion, 95 F.3d 1166 (Fed. Cir. 1996).

<sup>7</sup> The final rulemaking published on January 20, 1983, at 48 FR 2696-2714 and on February 1, 1983, at 1027 O.G. 9, contains the following comment:

Comment: Two comments were received which proposed that only a certificate of mailing procedure as in § 1.8(a) be used for determining the date of deposit under 35 U.S.C. § 221.

Reply: The filing date of an application is considered to be much more critical than the filing dates of papers accepted under § 1.8(a). The application filing date is often critical for determining if a statutory bar exists, whether foreign priority can be claimed and who is the senior party in an interference. Therefore, papers filed for purposes of receiving an application filing date should have some clear indication of the date of receipt by the United States Postal Service. Such a practice would also probably require storing all of the envelopes in the file wrapper for record purposes.

As explained in the final rulemaking, Express Mail service was found to be preferable because "a readily legible mailing date is provided to both the applicant and the Patent and Trademark Office on the 'Express Mail' label."

<sup>8</sup> In promulgating 37 CFR 1.10, the Office also considered other types of mail service (e.g., registered mail and certified mail) as a possible "Express Mail" service since this service provided a readily legible mailing date on the "Express Mail" label on the records of both the applicant and the Office. See, *Revision of Patent Procedure*, 48 Fed. Reg. at 2697-1, 27 (January 20, 1983), at 12-13.

<sup>9</sup> *Charlson Realty Co. v. United States*, 696 F.2d 134, 415 (Ct. Cl. 1987).

Petitioner has failed to establish that the Office should accept declarations as proof that portions of an application were submitted on the date of filing of the rest of the application.

Petitioner also argues that the pages may have been lost due to actions by the USPS. Petitioner states that the postcard receipt was discolored and brittle when received. A review of the papers in the file indicate that the application papers are not damaged. The file does not indicate whether or not the postcard was damaged prior to receipt by the Office or after the Office mailed the postcard back to applicant. Petitioner states that for UV radiation to be effective, "each sheet would require UV exposure." The Office is not aware of the USPS or any government agency routinely opening envelopes rather than radiating or treating the outside of the envelope. It is acknowledged that chemicals used on the outside of the envelope may seep through the envelope and damage papers inside. However, the present issue is whether the pages were actually received by the Office and not the condition of the papers when received by the Office.

Since applicants have not filed a petition under 37 CFR 1.182 requesting a filing date of April 11, 2002, the date the missing pages were filed, as the filing date, the pages filed on April 11, 2002, will not be entered. Although the current petition is labeled "Petition Under 37 C.F.R. § 1.182," petitioner does not request a filing date of April 11, 2002, and therefore the filing date will remain November 7, 2001, and the missing drawings will not be entered.

An amendment to the specification deleting references to the missing pages should be filed prior to the first USPTO action in order to avoid further delays in the examination of the application.

If petitioner desires for the examiner to consider pages which were not submitted as part of the original disclosure, then petitioner may seek to submit some or all of those pages as an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter. See MPEP 608.02(a).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By facsimile: (703) 308-6916  
Attn: Office of Petitions

By hand: Office of Petitions  
2201 South Clark Place  
Crystal Plaza 4, Suite 3C23  
Arlington, VA 22202

If a request of reconsideration, or petition under 37 CFR 1.182, is not filed within two months, the file will be forwarded to the Office of Initial Patent Examination for further processing with a filing date of November 7, 2001, using only the application papers filed on that date.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683

Charles Steven Brantley  
Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy